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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,473	09/29/2003	David Onstenk	100202194-2	5530

7590 03/08/2004
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

KRISHNAMURTHY, RAMESH

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/674,473	Applicant(s) ONSTENK ET AL.	
	Examiner Ramesh Krishnamurthy	Art Unit 3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 14 and 19 - 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 4, 8 - 10, 12- 14, 19 - 27, 32 and 33 is/are rejected.
- 7) ☒ Claim(s) 5-7, 11 and 28-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/29/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

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This office action is responsive to communications including the preliminary amendments filed 10/23/2003.

Claims 1 – 14 and 19 – 33 are pending.

The applicant is reminded to update the status of parent application(s) referred to on page 1 of the specification.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 8, 22 - 24, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Brewer (US 3,788,071) or Choksi (5,727,594).

Brewer discloses a check valve (44) comprising an outer region (that is attached to the housing) and a central region (74); a cut (63, 64) winding from the outer region towards the central region; and wherein the check valve opens by extending the central region away from the outer region and closes by retracting the central region towards the outer region.

Choksi discloses a check valve (54) comprising an outer region (58) and a central region (60), a cut (68) winding from the outer region towards the central region and wherein the check valve opens by extending the central region away from the outer region and closes by retracting the central region towards the outer region.

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Regarding claim 8, it is noted that the check valve of both Choksi and Brewer has a circular configuration.

Regarding claims 24, 32 and 33, it is noted that both Choksi and Brewer anticipate the method recited in claims 24, 32 and 33 since the devices disclosed respectively by Choksi and Brewer necessarily perform the method in its normal and usual operation.

3. Claims 1 – 4 and 19 – 27, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Pettit et al. (US 5,890,959).

Pettit et al. discloses a backflow preventer i.e. check valve (110) comprising an outer region (that is attached to the grate (170)), a central region and cut winding from the outer region towards the central region (Figs. 4 – 6, for example); and wherein the check valve opens (Fig. 6) by extending the central region away from the outer region in the presence of flow along one direction and closes by retracting the central region towards the outer region in the presence of flow in the reverse direction.

Regarding claims 2 – 4, it is noted that Pettit et al. discloses the air-moving device near which the check valve (110) is positioned could be either a blower or a fan.

Regarding claims 19 – 21, it is noted that Pettit et al. discloses a plurality of cooling components (Fig. 1) each having a check valve (110).

Regarding claims 24 – 27, 32 and 33, it is noted that Pettit et al. anticipates the method recited in claims 24 – 27, 32 and 33 since the device

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disclosed by Pettit et al. necessarily performs the method in its normal and usual operation.

4. Claims 9, 10, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Baddour et al. (US 6,031,717).

Baddour et al. discloses a check valve (12) having means (14) for expanding the check valve towards the center of a blower (20) to allow airflow in one direction and means (14) for collapsing the check valve (12) to limit airflow in the reverse direction. The various structural arrangements (Col. 3, lines 51 – 57) provide means for controlling the expansion of the check valve.

The device disclosed by Baddour et al. anticipates the method recited in claims 9 and 10 since the device disclosed by Baddour et al. necessarily performs the method in its normal and usual operation.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a

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later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pettit et al. (US 5,890,959).

Pettit et al. discloses the invention claimed with the exception of disclosing the check valve to be circular. However, provision of a circular shape for the check valve (110) disclosed by Pettit et al. that has a rectangular shape, pertains to a change in shape of a prior-art device. The applicant should note that a change in the shape of a prior art device has been held by the courts to be a design consideration that involves only routine skill in the art. In re Dailey, 357 F. 2d 669, 149 USPQ 47 (CCPA 1966).

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baddour et al. as applied to claims 9, 10, 13 and 14 above, and further in view of either Choksi (US 5,727,594) or Brewer (3,788,071).

The patent to Baddour et al. discloses the claimed invention with the exception of disclosing the step of retracting the central portion of the check valve when closing the check valve.

The check valves disclosed by Choksi and Brewer both involve retracting the central portion ((60) in Choksi and (74) in Brewer) during the valve closing position, as set forth above. Such an arrangement clearly requires a lesser actuating force than a valve such as that disclosed by Baddour et al. since the closing force has to act on a larger area that surrounds the central portion (16).

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Thus, the check valves disclosed by Brewer and Choksi offer closing of the check valves under much weaker reverse flows than the configuration disclosed by Baddour et al., thus providing better protection from outside contaminants.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided in the device of Baddour et al. a check valve arrangement disclosed by either Choksi or Brewer, for the purpose of closing the check valves under much weaker reverse flows than the configuration disclosed by Baddour et al., thus providing better protection from outside contaminants.

9. Claims 5 – 7, 11 and 28 – 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rudolph and Bertling et al. disclose a valving arrangement wherein a check valve element slides along a rod.

11. This is a continuation of applicant's earlier Application No. 10/094,527. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

12. Applicant's arguments filed 10/23/2003 have been fully considered but they are not persuasive. Applicant's argument concerning the references applied in the rejection set forth is that none of the applied references disclose or suggest a check valve including "a cut winding from the outer region towards the central region". However, as explicitly set forth in paragraphs 2 – 8 above, each applied reference does disclose a check valve including "a cut winding from the outer region towards the central region". It is noted that any limitation pertaining to the cut disclosed in the application but not recited in the claim(s) is not being read into the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramesh Krishnamurthy whose telephone number is (703) 305 5295. The examiner can normally be reached on Monday - Friday 8:30 - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Scherbel can be reached on (703) 308 1272.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ramesh Krishnamurthy
Examiner, GAU 3753